

REMARKS

Examiner Brier is thanked for the courtesies extended to Applicants' representative, Kevin McGoff, during a personal interview on May 23, 2006. At that interview it was agreed that an amendment to the independent claims along the lines of: "to create a layout image in a computer readable memory for later presentation of the image to a user" would address the §101 rejection. It was also agreed that an amendment to the independent claims along the lines of: "the document image data in the extracted at least one document block represents fewer document images than all the document images that are present on the scanned document" would address the §112 rejection relating to extracting a document block having "less" document image data than the entire digital image.

In view of the agreements reached during the Interview, the foregoing amendments are made and the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections.

Objections to the Specification

The Official Action objects to the specification because it recites that "photographic images (including graphics) exist in the document image data." The Official Action reasons that such a recitation is unclear because "a photograph does not usually include graphics and the specification as a whole does not teach photographs with graphics."

Applicants assert that the above recitation is understandable by one skilled in the art. That is, the recitation states that the photographic image area 20 contains photographic images and graphic images. Even if not the most often used wording,

there is nothing ambiguous or impossible about having photographic images and graphic images in a certain area (or data), e.g., area 20, the photographic image area (data).

Further, the Applicants are entitled to use language that is not normally used in the art. MPEP § 2111.01 (III) states that "[a]n applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning."

Therefore, the recitation at issue is not unclear or impossible and cannot form a basis for the objection to the specification, and such should be withdrawn.

Rejections based on 35 U.S.C. § 112

Claims 1-34 and 37-47 under 35 U.S.C. § 112, first paragraph

The Official Action raises issues with regard to Claims 1, 9, 17, 27, 32 and 33 for allegedly not being supported by the original disclosure. Specifically, it is alleged that the claim recitation "each portion of the document image data including at least one of character image data representing character images and photographic image data representing photographic images and graphic images" is new matter.

That claim language has been removed, thereby obviating that rejection.

However, in the interest of rebutting the Examiner's assertions, it is pointed out that paragraph [0035] of the specification was amended to recite "image area 20 containing a photographic image (including graphics)." Support for that amendment can be found in the priority document, Japanese Application No. 2000-267305. The

present application incorporates the priority application by reference. Accordingly, the amendment was not new matter.

The Official Action also raises issues regarding Claims 1, 9, 17, 27, 32 and 33 based on an allegation that the specification does not disclose an extracted document block being less than the document data in an entire digital image. That is, the Examiner believes that the pre-scan scans the entire page, thereby locating the marked area, and that the main-scan only scans the marked area of the page. The Examiner concludes that all the image area scanned in the main-scan is extracted and that the document data from the main-scan is therefore not less than the entire digital image (marked area on main-scan).

That interpretation is not necessarily agreed with and the Applicants reserve the right to challenge such interpretation at a later time.

Nevertheless, as discussed during the Examiner Interview, to more clearly define the claimed subject matter, Claim 1 is amended to generally define that the document image data in the extracted at least one document block represents fewer document images than are present in the scanned document. Claims 9, 17, 27, 32 and 33 are similarly amended. That subject matter is clearly supported in the present application, for example, in Figure 4 and corresponding descriptions that illustrate that the extracted data represents fewer document images than are present in the scanned document.

The Official Action raises an issue with regard to Claims 21 and 33 because they recite "at least one circuit," while the specification allegedly only describes one circuit. That is, the Examiner believes that the disclosure of multiple circuits in the specification is limited by the one circuit illustrated in the drawings.

The Examiner is reminded that not every embodiment of the invention disclosed in the specification must be shown in the drawings. That is, the disclosure is not limited to only that shown in the drawings. 37 C.F.R. § 1.81(a) (emphasis added) states that "[t]he applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented..." The drawings provided in the present application, *i.e.*, the single circuit, are adequate and do not limit the disclosure to a single circuit because a skilled person would understand that a single or plural circuit can be used, especially because the specification refers to plural circuits. Should this rejection be maintained, it is requested that it be explained why two circuits must be illustrated to communicate to a skilled person that two circuits can be used.

For at least those reasons, all the claim language at issue, and especially all the present claim language, is fully supported by the specification and it is requested that the rejections under 35 U.S.C. § 112 be withdrawn.

The Official Action also raises an issue relating to the language in Claims 42-47 relating to font size. That is, the Examiner is concerned that Claims 42-47 recite "at least one font size." However, Applicants point out that Claims 42-47 do not recite at least "one" font size, but rather, "at least font size." For at least that reason, the Examiner's concerns are obviated and the rejection should be withdrawn.

Rejection under 35 U.S.C. § 101

Claims 1-34 and 37-41 under 35 U.S.C. § 101

The Examiner is of the belief that the recitation in Claims 1, 9, 17, 27, 32 and 33 relating to a layout means laying out the character code lends itself to abstract

manipulations and the abstract result. Though Applicants feel that this position could be traversed, in the interest of expediting prosecution of this application, Claims 1, 9, 17, 27, 32 and 33 are amended to more clearly fall within the realm of statutory subject matter. Based on suggested claim language set forth in the Official Action, the claims are amended to more clearly define steps that could not be performed mentally and which produce a more clearly tangible result. For example, Claims 1, 9, 17, 27, 32 and 33 include recitations directed to laying out the character code data within the reconstructed at least one document block to create a layout image in a computer for presentation of the image to a user.

As agreed to during the Examiner Interview, for at least that reason, the rejection of Claims 1, 9, 17, 27, 32 and 33 should be withdrawn.

Conclusion

For at least the reasons stated above, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections.

In the event that there are any questions concerning this amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

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